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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,586	08/04/2000	Hisashi Sakakibara	1536.1002 (JDH)	1897

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER
CHANNAVAJJALA, SRIRAMA T

ART UNIT	PAPER NUMBER
2177	

DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

	Application No.	Applicant(s)
Office Action Summary	09/632,586	SAKAKIBARA, HISASHI
	Examiner	**Art Unit**
	Srirama Channavajjala	2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _27 June 2003_ .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-9_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-9_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a)

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _3_ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

DETAILED ACTION

Response to Amendment

1.   Examiner acknowledges applicants' amendment filed on 6/27/2003, paper no.6

2.   Claims 6-9 have been added, paper no. # 6.

3.   Claims 1-9 are pending in this application.

Drawings

4.   The drawings filed on 08/04/2000 are <u>approved</u> by the Draftsperson under

37 CFR 1.84 or 1.152.

Information Disclosure Statement

5.   The information disclosure statement filed on 10/11/2000, paper no. # 3, has

been considered, a copy of PTO-1449 was enclosed with this office action,

paper no. # 7.

Priority

6.   Acknowledgment is made of applicant's claim for foreign priority under

35 U.S.C. 119(a)-(d). A certified copy of Japanese patent application No.

2000-85057 filed on 3/4/2000 has been filed in present Application No. **09/632,586,**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Horstmann et al., [hereafter Horstmann] in view of Walker et al., [hereafter Walker],

US Patent No. 6327573.

8.   As to Claim 1, Horstmann teaches a system which including 'a first business

entity, a second business entity who cooperates with said first business entity and

customers of the first and second business entities' [page 5, line 15-16], Horstmann

teaches automated processing of business entities, more specifically as detailed in fig 2,

elements 210,220,230,240-250 are used to process business entities over the computer

network, examiner interpreting first business entity corresponds to Horstmann's

business entity A, second business entity corresponds to business entity B;

'first business entity managing communication on-line services, second business entity

managing customers activity' [page 4, line 24-29, page 12, 4-11], Horstmann specifically

teaches for example a distributed business entity that may have multiple business

entities such as business entity A, and business entity B, C and like as detailed in fig 2

and they are communicating through a computer network element 200, further

Horstmann suggests computer network can be Internet or any wide area network

[page 10, line 18-19], 'instructing said first business entity by said customer to exchange

communication' [page 8, line 25-29, page 9, line 1-3, page 12, line 20-25], Horstmann

teaches firstly automated processing of business entities such as detailed in fig 2, these

business entities are distributed over computer network, it is also noted that first

business entity , second business entity information exchanged over network,

'requesting said second business entity by said first business entity' [page 12, line 6-10],

'sending request by second business entity to said first business entity, exchanging

communication by first business entity' [see fig 2, page 12, line 4-19]. It is however,

noted that Horstmann does not teach 'managing valuable points given to customers as

a reward for consumption activity', 'send valuable points given to the customer',

exchanging received valuable points according to a present exchange rate'. On the

other hand, Walker teaches a system which including 'managing valuable points given

to customers as a reward for consumption activity' [see Abstract, col 1, line 6-9, col 2,

line 14-18], Walker is directed to reward system for consumers or customers for

example in a retail sales or service transaction environment [col 3, line 8-11], further

Walker also suggests for example customers can earn points for their purchase or

transaction [col 1, line 43-44], examiner interpreting managing valuable points

corresponds to Walker's incentive reward for consumers or customers, 'send valuable

points given to the customer' [col 2, line 66-67, col 3, line 1-7], Walker specifically

suggests for example member or account holders are linked to frequent shopper

account that will identify appropriate account holder to receive valuable points based on

the transaction as detailed in col 3, line 1-7, 'exchanging received valuable points

according to a present exchange rate' [col 4, line 49-63], Walker teaches for example

relationship between frequent shopper database and associated rules that not only

determines the transaction profile data, but also predefined reward level or reward

points for frequent shopper account as detailed in col 4, line 54-63.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to incorporate the teachings of Walker et al. into automated processing of

business entities distributed over a network of Horstmann et al., because they both are

directed to business transaction environment, for example Horstmann is directed to

processing business entities over a computer network, more specifically establishing

hierarchical relationship between various business entities, defining business rules,

attributes of each business entity as detailed in fig 3, while Walker is directed to

frequent shopper reward system for customers or consumers in a business

environment, more specifically identifying each customer, determining account holders,

reward level and other information associated with each member, further establishing

relationship between various objects related to transaction, shopper database, and

customer profile for grating rewards or valuable points [col 4, line 40-63].

One of the ordinary skill in the art at the time of the invention would have been

motivated to modify Horstmann's reference to incorporate tracking and rewarding

valuable points to customers or consumers in a retail sales and/or service transaction

environment where multiple business entities are part of retail sales or service

transaction of Walker, more specifically modifying data structure, business rules of

Horstmann's fig 3 to incorporate reward program, frequent shopper database, frequent

shopper rules database elements 340,400A-400B of Walker fig 3C because that would

have allowed users of Horstmann's automated processing of business entities

distributed over a network to control each customer or consumers incentive rewarding

or granting valuable point based on customer participating in various program(s) that

related to various business entities as suggested by Walker et al. [col 2, line 14-29].

9.   As to Claims 2,4-5, Horstmann teaches a system which including "on-line

services' [page 10, line 18-19], on line services corresponds to Internet that is used for

various processing, transmitting various business related information, for example

making reservation and like as detailed in Abstract, 'a cooperate-user terminal unit that

is connected to said central unit' [fig 1-2], 'customer-use terminal unit comprises a

controller capable of performing the operation of transmitting to said central unit

exchange instructing information' [see Abstract, page 4, line 24-29, fig 1-2], 'a

communication point database that records information' [page 5, line 15-20], databases

corresponds to Horstmann's databases elements 215,225,235 as detailed in fig 2,

'updating database' [page 5, line 22-24], both Horstmann and Walker teach operation of

transmitting to said cooperate user terminal unit [see Horstmann: see fig 2, Abstract;

Walker: fig 1-2, col 3, line 17-22], however, it is noted that Horstmann does not teaches

'information related to communication points, exchange database that records

information related to an exchange rate between communication points and valuable

points, 'valuable point request information requesting valuable points corresponding to

the customer-use terminal unit according to received exchange instructing information','

updating valuable point database'. On the other hand, Walker teaches a system which

including 'information related to communication points' [col 3, line 1-7], 'exchange

database that records information related to an exchange rate between communication

points and valuable points' [col 4, line 16-33, col 6, line 39-45], "valuable point request

information requesting valuable points corresponding to the customer-use terminal unit

according to received exchange instructing information' [col 4, line 46-63],' updating

valuable point database' [fig 2, col 12, line 27-48].

It would have been obvious to one of ordinary skill in the art at the time of the

invention to incorporate the teachings of Walker et al. into automated processing of

business entities distributed over a network of Horstmann et al., because they both are

directed to business transaction environment, for example Horstmann is directed to

processing business entities over a computer network, more specifically establishing

hierarchical relationship between various business entities, defining business rules,

attributes of each business entity as detailed in fig 3, while Walker is directed to

frequent shopper reward system for customers or consumers in a business

environment, more specifically identifying each customer, determining account holders,

reward level and other information associated with each member, further establishing

relationship between various objects related to transaction, shopper database, and

customer profile for grating rewards or valuable points [col 4, line 40-63].

One of the ordinary skill in the art at the time of the invention would have been motivated to modify Horstmann's reference to incorporate tracking and rewarding valuable points to customers or consumers in a retail sales and/or service transaction environment where multiple business entities are part of retail sales or service transaction of Walker, more specifically modifying data structure, business rules of Horstmann's fig 3 to incorporate reward program, frequent shopper database, frequent shopper rules database elements 340,400A-400B of Walker fig 3C because that would have allowed users of Horstmann's automated processing of business entities distributed over a network to control each customer or consumers incentive rewarding or granting valuable point based on customer participating in various program(s) that related to various business entities as suggested by Walker et al. [col 2, line 14-29].

10.   As to Claim 3, the limitations of this claim have been noted in the rejection of Claim 2 above. In addition, both Horstmann and Walker disclosed 'authentication' [page 13, line 15-29,page 14, line 1-4; Walker: col 3, line 30-33], specifically Walker suggests user or person or customer to be identified for granting access to the system as detailed in col 3, line 30-37 that corresponds to authenticating customer user terminal unit to receive person's identification information, also see fig 8A-8B.

11.   Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Horstmann et al., [hereafter Horstmann] in view of Ng, US Patent No. 6405175.

As to Claim 6, Horstmann teaches a system which including 'business entities'

[page 5, line 15-16], business entities corresponds to Horstmann's business entity, B ,

'responsive to a customer purchasing a good or service from a first business entity that

offers various types of goods or services' [page 11, line 1-6], various types of goods or

services corresponds to travel agency or hotel services, 'automatically crediting to the

customer non-monetary first points of a type' [page 12, line 10-13], 'first business entity

agrees to upon conditions' [page 12, line 10-16]. However, it is noted that Horstmann

does not specifically teach 'redeem to the customer the credited non-monetary first

points in exchange for any of the goods or services of the various types offered by the

first business entity', 'in response to an interactive request of the customer, exchanging

the credited non-monetary first points for non-monetary second points of a type',

'redeem to the customer the credited non-monetary second points in exchange for any

of goods or services of various types offered by the second business entity, where the

first points and the second points are of types that are not fungible' . On the other hand

Ng disclosed 'redeem to the customer the credited non-monetary first points in

exchange for any of the goods or services of the various types offered by the first

business entity' [see Abstract, col 4, line 65-67, col 5, 1-9], col 7, line 15-23], 'in

response to an interactive request of the customer, exchanging the credited non-

monetary first points for non-monetary second points of a type'[col 7, line 61-67, col 8,

line 23-32] , 'redeem to the customer the credited non-monetary second points in

exchange for any of goods or services of various types offered by the second business

entity, where the first points and the second points are of types that are not fungible'

[col 8, line 33-67].

It would have been obvious to one of ordinary skill in the art at the time of the

invention to incorporate the teachings of Ng. into automated processing of business

entities distributed over a network of Horstmann et al., because they both are directed

to business transaction environment, for example Horstmann is directed to processing

business entities over a computer network, more specifically establishing hierarchical

relationship between various business entities, defining business rules, attributes of

each business entity as detailed in fig 3, while Ng is directed to shopping scouts web

site for rewarding customer referrals on product and price information with rewards

scaled by the number of shoppers using the information, more specifically users

searching various business entities for various products and awarding rewards for

product submission [see Abstract]. One of the ordinary skill in the art at the time of the

invention would have been motivated to combine the reference because that would

have allowed users of Horstmann's business entities over a computer network to

sharing rewards among various users for their specific product purchase or services, as

suggested by Ng [see Abstract, col 3, line 28-40], thus improves the quality and

reliability of the system.

12.   As to Claim 7, the limitation of this claim have been noted in the rejection of Claim 6 above. In addition, Ng disclosed 'exchanging de-crediting the first points from the customer' [col 8, line 61-67].

13.   As to Claim 8-9, the limitation of this claim have been noted in the rejection of Claim 6 above. In addition, Ng disclosed 'first points and second points are exchanged according to electronic exchange rate information' [col 8, line 61-67, col 9, 1-18].

Response to Arguments

a)   At page 7, line 30-31, Claims 1,2,4-5, applicant argues Horstmann does not teach "business entities" as recited in the pending claims and Walker was not cited for and does not teach.......

As to the above argument (a), examiner disagree with the applicant because Horstmann is directed to processing of business entities over a network, more specifically, processing various business related aspects for example making a reservation, airlines, hotels and car rental companies and like have various business attributes and business rules into business entities as detailed in page 6, line 20-22, Also, it is noted in the office action that Horstmann specifically directed to first and second business entities for example first business entity and second business entity corresponds to Horstmann's fig 2, elements 210,220,230,240-250, therefore, as best

understood by the examiner Horstmann teaches "business entities". On the other hand, Walker et al is directed to multiple party reward system, more specifically frequent shopper reward system that tracks account holders to a single frequent shopper account related to various business entities such as retail sales, service transaction environment [see Abstract, col 3, line 8-16] and both Horstmann and Walker et al., are directed to processing business entities over computer network and are from same field of endeavor.

b)   At page 8, Claim 1, Applicant argues, "walker does not teach exchanging points.....

As to the above argument (b), examiner disagree with the applicant because Walker is directed to multiple party reward system, more specifically rewarding frequent shopper or account holders, also Walker suggests for example member or account holders are linked to frequent shopper account that will identify appropriate account holder to receive valuable points based on the transaction as detailed in col 3, line 1-7, further it is noted that frequent shopper database and associated rules together determines reward level or reward points or valuable points for frequent shopper account holder.

c)   At page 9, Claim 2, 'a controller capable......user terminal unit valuable point.......exchange instructing information....is not taught or suggested.......

As to the above argument (c), both Horstmann and Walker teach operation of transmitting to said cooperate user terminal unit [see Horstmann: see fig 2, Abstract; Walker: fig 1-2, col 3, line 17-22], however, Horstmann does not specifically teach 'valuable point request information requesting valuable points corresponding to the customer-user terminal unit according to received exchange instructing information. On the other hand Walker disclosed 'valuable point request information requesting valuable points corresponding to the customer-user terminal unit according to received exchange instructing information' [see col 4, line 46-63], Walker specifically suggests for example rules defining the reward level or reward points assessed to a frequent shopper account in response to transaction corresponds to exchange instructing information.

Conclusion

The prior art made of record

a.   WO 99/03053

b.   US Patent No.   6327573

c.   US Patent No.   6405175

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

d.   US Patent No.   6424951

e.   US Patent No.   6381585

f.   US Patent No   6029141

g.   US Patent No   5839114

h.   US Patent No   6351738

i.   US Patent No   6249769

j.   EP0992952

k.   WO 98/29822

l.   WO9103789

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Srirama Channavajjala whose telephone number is (703) 308-8538. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:30 PM Eastern Time. The TC2100's Customer Service number is (703) 306-5631.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene, can be reached on (703) 305-9790. The fax phone numbers for the organization where the application or proceeding is assigned are as follows:

703/746-7238   **(After Final Communication)**

703/746-7239   **(Offical Communications)**

703/746-7240   **(For Status inquiries, draft communication)**

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

sc

Patent Examiner.

July 25, 2003.